REMARKS

Applicants ask that all claims be allowed in view of the amendments to the claims and the following remarks. Claims 1-23, 35-38, and 40-64 are now pending, with claims 1, 35, and 62 being independent. Claim 59 has been cancelled, claims 1, 9-11, 14-16, 23, 35, 56-58, and 60 have been amended, and claims 61-64 have been added by way of this Amendment. Support for the amendments can be found in the Application, for example, at page 22, line 24 to page 24, line 28 and page 25, lines 11-31.

Claim Objections

The Office Action objected to claims 1, 16, 35, and 60 as appearing to include minor typographical errors. Applicants have amended claims 1, 35, and 60 as suggested by the Office Action. Applicants also have amended claim 16 – though not as suggested by the Office Action – and submit that the amendment to claim 16 renders the objection moot. Accordingly, applicants request reconsideration and withdrawal of the objection to claims 1, 16, 35, and 60.

Claim Rejections Under 35 U.S.C. § 101

Claims 35-38 have been rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter. In particular, the Office Action contends that the computer readable medium recited in claim 35 may read on a propagated signal and that, therefore, claims 35-38 recite non-statutory subject matter.[1] See Office Action of January 24, 2008 at page 3, line 14 to page 4, line 6.

Applicants traverse this rejection. Nevertheless, without conceding the propriety of this rejection but rather to advance prosecution, applicants have amended independent claim 35 to recite that the computer readable medium is tangible. Accordingly, applicants request

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[1] Applicants note that claims 36-38 recite respectively that the computer readable medium is disc, a client device, and a host device, each of which precludes the recited computer readable medium from reading on a propagated signal. Accordingly, applicants submit that, irrespective of the propriety of the rejection of claim 35 under 35 U.S.C. § 101, claims 36-38 should not have been subject to this rejection under 35 U.S.C. § 101.

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reconsideration and withdrawal of the rejection of independent claim 35 and its dependent claims, claims 36-38.

Claim Rejections Under 35 U.S.C. § 102

Independent claims 1 and 35 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,136,903 (Phillips) or, in the alternative, as being anticipated by U.S. Patent No. 6,487,583 (Harvey). Dependent claims 2-23, 36-38, and 40-60 each depend from one of independent claims 1 and 35 and have been rejected under 35 U.S.C. § 102(e) and/or 35 U.S.C. § 103(a) as being unpatentable in view of one or more of Phillips, Harvey, U.S. Patent Application Publication No. 2001/0013050 (Shah), U.S. Patent No. 6,993,325 (Waesterlid), U.S. Patent No. 6,396,512 (Nickerson), U.S. Patent No. 6,701,343 (Kenyon), and U.S. Patent No. 6,366,907 (Fanning). Applicants have amended independent claims 1 and 35 and request reconsideration and withdrawal of the rejection of claims 1-23, 35-38, and 40-60 because neither Phillips nor Harvey describes or suggests all of the features recited in independent claims 1 and 35 and because none of Shah, Waesterlid, Nickerson, Kenyon, and Fanning cures the deficiencies of Phillips and Harvey.

As amended, independent claim 1 recites a computer implemented method that includes, among other features, storing, on a host system and for a group, a single copy of a member-only collection of contact information that is associated with and accessible to members of the group and that includes contact information for each member of the group.

Phillips discloses a multi-user file storage system that enables users within a pre-subscribed user group to access files that are associated with the pre-subscribed user group and that are stored on a remote file server. See, e.g., Phillips at Abstract. Importantly, however, Phillips does not describe or suggest a collection of contact information that is accessible to members of the group and that includes contact information for each member of the group on the remote file server. Accordingly, Phillips fails to describe or suggest storing, on a host system and for a group, a single copy of a member-only collection of contact information that is

associated with and <u>accessible to members of the group</u> and that <u>includes contact information for
each member of the group</u>, as recited in independent claim 1.

Harvey, like Phillips, also fails to describe or suggest storing, on a host system and for a
group, a single copy of a member-only <u>collection of contact information</u> that is associated with
and <u>accessible to members of the group</u> and that <u>includes contact information for each member
of the group</u>, as recited in independent claim 1.

Harvey discloses a system for distributing community applications and information
through a network to enable users to interact and communicate with like-minded communities.
<u>See, e.g.</u>, Harvey at col. 1, lines 9-15. According to Harvey's disclosure, Harvey's system
provides a user with several features including, among others, a "Pal Function" and a "Mailing
List" function.

As described by Harvey, the "Pal Function . . . may allow a user to maintain a 'Pals' list
of people whom they wish to have available for communication at all times." Harvey at col. 17,
lines 18-20. Importantly, there is no suggestion in Harvey that members of a community share
(or otherwise have access to) a common "Pals list." Rather, Harvey describes that a user's "Pals
list" is personal to the user. Furthermore, there is no suggestion in Harvey that a user's personal
"Pals list" includes contact information for each member of a community to which the user
belongs. Rather, Harvey describes that a user's "Pals list" includes contact information for those
people "whom [the user wishes] to have available for communication at all times." As such, the
"Pal's list" disclosed by Harvey is not a collection of contact information that is associated with
and <u>accessible to members of a group</u> and that <u>includes contact information for each member of
the group</u>, as recited in independent claim 1.

The "Mailing List" function disclosed by Harvey is similarly deficient. As described by
Harvey, "[m]ailing lists may allow a user or administrator to send email to a group of people in a
community. An email sent to a list may be distributed to all currently subscribed members of the
list." Harvey at col. 18, lines 45-48. Importantly, there is no suggestion in Harvey that a user
can access (or otherwise discern) contact information for members of a community from a
mailing list. Rather, Harvey's "Mailing List" function appears to enable a user to send an email

to multiple users by sending an email to a single address (i.e., a mailing list) that is then responsible for distributing the email to each of the multiple users. Accordingly, Harvey's "Mailing List" also does not amount to a collection of contact information that is associated with and <u>accessible to members of a group</u> and that <u>includes contact information for each member of the group</u>, as recited in independent claim 1.

Like Harvey's "Pals list" and Harvey's "Mailing List," no other feature provided to a user of Harvey's system amounts to a collection of contact information that is associated with and <u>accessible to members of a group</u> and that <u>includes contact information for each member of the group</u>, as recited in independent claim 1.

For at least the foregoing reasons, applicants submit that neither Phillips nor Harvey anticipates amended independent claim 1. Accordingly, applicants request reconsideration and withdrawal of the rejection of independent claim 1.

As amended, independent claim 35 recites features that are similar to those discussed above in connection with independent claim 1 and does so in the context of a computer readable medium. Accordingly, applicants request reconsideration and withdrawal of the rejection of amended independent claim 35 for at least the reasons discussed above in connection with amended independent claim 1.

As discussed above, dependent claims 2-23, 36-38, and 40-60 each depend from one of independent claims 1 and 35 and have been rejected under 35 U.S.C. § 102(e) and/or 35 U.S.C. § 103(a) as being unpatentable in view of one or more of Phillips, Harvey, Shah, Waesterlid, Nickerson, Kenyon, and Fanning. However, none of Shah, Waesterlid, Nickerson, Kenyon, and Fanning cures the deficiencies in Phillips and Harvey noted above. Accordingly, at least because of their dependencies and for the reasons discussed above in connection with amended independent claims 1 and 35, applicants request reconsideration and withdrawal of the rejection of dependent claims 2-23, 36-38, and 40-60.

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New Claims

New dependent claim 61 depends directly from independent claim 1. Accordingly, applicants submit that new dependent claim 61 is allowable at least because of its dependencies and for the reasons discussed above in connection with independent claim 1.

New independent claim 62 recites a method that includes determining that a change in the membership of a passively dynamic group of instant messaging participants has occurred that was not inspired by an instant messaging identity and automatically triggering, without involvement from the instant messaging identity, an updating of the displayed instant messaging participant list to reflect the change in the membership of the passively dynamic group of instant messaging participants.

None of the references of record appear to recite these features of new independent claim 62. Accordingly, applicants submit that new independent claim 62 and its dependent claims, claims 63 and 64 are allowable.

Conclusion

Applicant submits that all claims are in condition for allowance.

It is believed that all of the pending issues have been addressed. However, the absence of a reply to a specific rejection, issue, or comment does not signify agreement with or concession of that rejection, issue, or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this reply should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this reply, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

The fee in the amount of $360 in payment of the Excess Claims Fee is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to Deposit Account No. 06-1050.

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Respectfully submitted,

Date: _April 24, 2008_

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